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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,741	01/03/2001	Hideo Sugimoto	P20188	1183

7055 7590 01/26/2005

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RESTON, VA 20191

EXAMINER	
SENFI, BEHROOZ M	

ART UNIT	PAPER NUMBER
2613	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/752,741	SUGIMOTO ET AL.	
	Examiner	Art Unit	
	Behrooz Senfi	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/1/2004, fwd 11/10/204*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed 9/1/2004 have been fully considered but they are not persuasive.

Response to remarks:

Regarding the filing date "as raised by applicant" of the application being prior to the patented filing date, please note that a terminal disclaimer is needed to keep the patents commonly assigned.

With regards to applicant's argument (filed 9/1/2004, page 4, lines 4 – 17) that Two-way obviousness requirement, the two-way obviousness test is to be applied only when the applicant could not have filed the claims in a single application and there is administrative delay. In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998). However, applicant has not provided evidenced or reason to the two conditions above. Lacking such evidence/reason, a one-way obviousness is appropriate. In re Goodman, 11 F. 3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). (Please see MPEP 804). For the reason as stated, the one-way obviousness double patenting is proper.

Applicants note that (page 3, first paragraph of remarks, filed 9/1/2004) that the examiner has rejected all of claims 1 – 5 under the obviousness type double patenting, and further includes that claim 6 of the cited patent does not recite "gains and gamma" factors, therefore the previous rejection (paper no. 6, dated 6/3/2004) is inappropriate.

In response, the nonstatutory obviousness-type double patenting applies to independent claims 1 and 5 of the present application as being unpatentable over claim

6 (which includes claims 1, 2, 4 and 5) of US patent 6,717,609, as cited in the body of the previous rejection statement (paper no. 6, dated 6/3/2004), and examiner considered independent claims 1 and 5 of the present application relevant and obvious over claim 6 (including claims 1, 2, 4 and 5) of the cited US patent 6,717,609 for the same reason as stated in the previous rejection.

With regards to "adjusting/controlling gains and gamma ..." as cited in the dependent claims 2 – 3.

Examiner (with respect to the grounds of rejection "obviousness type"), considered those limitations as being notoriously obvious and known to one skilled in the art (field of video processing) at the time of the invention was made, as for supporting the examiner position, please see US patent 5,291,276 (fig. 1, unit 3, AGC "gain controller" and unit 27 "gamma correction/controlling"), and the limitation "start to process video signals fed from newly selected electronic endoscope ....." as cited in the dependent claim 4, would have been obvious over claim 6 (including claims 1, 2, 4 and 5) of the US patent 6,717,609, since the image processor would process and display the images with respect to selected electronic endoscope. Therefore the previous ground of rejection is proper and still applies. The grounds are being restated for applicant convenience.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

> Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 – 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,717,609. Although the conflicting claims are not identical, they are not patentably distinct from each other because, the present claims 1 and 5 of the present application are broader than the patented claim 6 of US patent 6,717,609. Allowing claims 1 – 5 of the instant application would unduly extend the timewise monopoly f the patent. Applicant needs to submit a terminal disclaimer.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Behrooz Senfi** whose telephone number is **(703)305-0132.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Chris Kelley** can be reached on **(703)305-4856.**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relative to the status of the application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

B. S. B. S.

1/23/2005

CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600